

REMARKS

Claims 1-22 are all of the claims presently pending in the application. Claim 8 has been amended to more particularly define the claimed invention.

Applicant gratefully acknowledges the Examiner's indication that claims 9-13 and 19-22 are allowed. Applicant, however, maintains that all of claims 1-22 are allowable over the cited prior art references.

Claims 1-7 and 14-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over AAPA in view of Nakamura (U.S. Patent No. 6,243,563) and JP 09-046110 (hereinafter "JP '110"). Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over AAPA in view of JP 09 '110

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention (e.g., as defined by exemplary claim 1) is directed to a portable telephone set including a detector for detecting a better receiving sensitivity one of radio signals received by an exclusive receiving antenna for only receiving radio signals and a transmitting and receiving antenna for transmitting and receiving radio signals, a switch provided in a first housing for selecting the radio signal determined in the detector to be the better receiving sensitivity one, and a radio circuit provided in a second housing for demodulating the radio signal from the switch (e.g., see Application at page 5, lines 16-25).

The claimed invention, of exemplary claim 1, provides a portable telephone capable of efficient inter-housing transmission of radio signals (see Application at page 5, lines 12-15). Furthermore, the claimed invention provides a portable telephone set with reduced size and weight (see Application at page 5, lines 9-11).

II. THE REJECTIONS BASED ON PRIOR ART REFERENCES

A. Claims 1-7 and 14-18

The Examiner alleges that the AAPA would have been combined with Nakamura and JP '110 to form the claimed invention of claims 1-7 and 14-18. Applicant submits, however, the Examiner has failed to establish a prima facie case of obviousness.

First, Applicant maintains the traversal arguments provided in the Amendment filed Amendment filed on January 9, 2007. The substance of the previous traversal arguments is incorporated herein by reference and is not fully repeated, for brevity.

Specifically, Applicant maintains that the Examiner has failed to establish that one of ordinary skill in the art would have been motivated to modify the device in the AAPA as suggested by the Examiner to obtain the specific structure recited in the claims. This is the modification that the Examiner has the burden to show. The present rejection merely implies that this modification can be made, but does not establish that one of ordinary skill the art would have been motivated to make this modification. Indeed, this feature of the claimed invention is not taught or suggested in any of the cited prior art references (taken alone or in combination).

Second, Applicant submits that the applied prior art references would not have been combined as alleged by the Examiner.

That is, the Examiner alleges:

“AAPA doesn’t expressly teach a switch for selecting a better detected receiving signals. Nakamura teaches that a detected switch circuit for selecting a better signal between a common antenna and reception dedicated antenna. It would have been obvious to one ordinary skilled in the art to combine the teaching of Nakamura with AAPA such that without such switch the portable phone is hardly to select a better signal.” (See Office Action dated March 26, 2007 at page 4; emphasis added).

The Examiner, however, is clearly incorrect.

Applicant points out that one of ordinary skill in the art would not have been motivated to modify the device of the AAPA by combining the switch circuit of Nakamura with the device of the AAPA because the AAPA already includes a device for detecting a better signal between received signals.

Indeed, the radio circuit 2 of the AAPA detects a better receiving sensitivity one of the input radio signals and demodulates the better receiving sensitivity signal (see Application at page 4, lines 6-9).

The Examiner’s alleged motivation for combining Nakamura with the AAPA is that “without such switch the portable telephone is hardly to select a better signal”. This allegation by the Examiner is without merit. Indeed, the Application clearly sets forth that the radio circuit 2 of the AAPA already provides this function. Therefore, the Examiner’s allegation

that “without such switch the portable telephone is hardly to select a better signal” is clearly erroneous.

Moreover, one of ordinary skill in the art would not have been motivated to modify the AAPA as suggested by the Examiner because such modification would change the principle of operation of the device of the AAPA.

The AAPA teaches that received radio signals are transmitted to the radio circuit 2. The radio circuit 2 then detects the better receiving sensitivity one of the signals and demodulates the better receiving sensitivity radio signal (e.g., see Application at page 4, lines 1-10).

In stark contrast, Nakamura provides a switch controller 11 for selecting a RSSI signal with a higher level from two RSSI signals (see Nakamura at column 6, lines 11-20). However, Nakamura teaches that the RSSI signals are demodulated by the demodulator 6 prior to being transmitted to the switch controller 11 (see Nakamura at Figure 2). Accordingly, the demodulator receives and demodulates both signals, which are then transmitted to the switch controller.

Thus, the Examiner’s alleged modification would change the principle of operation of the AAPA.

Applicant points out that M.P.E.P. § 2143.01 states: “If the proposed modification or combination of the prior art would change the principal of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.”

Therefore, Applicant respectfully submits that these references would not have been combined as alleged by the Examiner. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

B. Claim 8

The Examiner alleges that the AAPA would have been combined with JP ‘110 to teach the claimed invention of claim 8. Applicant submits, however, that there are elements of the claimed invention, which are neither taught nor suggested by the AAPA.

That is, the alleged combination of the AAPA and JP ‘110 does not teach or suggest “*a switch for selecting a radio signal determined to be the better receiving sensitivity signal*”, as recited by exemplary claim 8.

Indeed, the Examiner does not even allege that the AAPA nor JP '110 teaches or suggests this feature of the claimed invention.

Therefore, Applicant respectfully submits that there are elements of the claimed invention that are neither taught nor suggested (nor made obvious) by the alleged combination of the AAPA and JP '110). Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

III. FORMAL MATTERS AND CONCLUSION

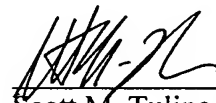
In view of the foregoing, Applicant submits that claims 1-22, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: May 31, 2007



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